

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

V Secret Catalogue, Inc. and Intimate Beauty
Corporation, d/b/a Victoria's Secret Beauty,

Opposers,

v.

Rick Worobec,

Applicant.

Consolidated Opposition No.
91162422

APPLICANT'S REPLY TO
OPPOSER'S OPPOSITION TO
MOTION FOR SUSPENSION OF
THE PROCEEDINGS

Applicant's motion for suspension of the present proceeding (Opposition No. 91162422) was opposed by Opposers in their responsive brief filed March 1, 2005. Applicant respectfully submits that suspension of the present opposition is warranted and justified.

Opposers' filed the present opposition based on the mark, SO SEXY, as allegedly used by Opposers in connection with hair care products. In seeking to move forward without delay, Opposers claim the interests of justice and fairness, yet neither may be achieved if the present opposition proceeds without the benefit of a final decision being made in Opposition No. 91125739 ("the '739 Opposition").

In the '739 Opposition, Sexy Hair Concepts, LLC opposed V Secret Catalogue, Inc.'s application on the basis that Opposers' mark SO SEXY is confusingly similar to Sexy Hair Concept's SEXY HAIR name and mark and its family of SEXY trademarks. The reality is that the '739 Opposition is near the end. The 15-day period for rebuttal testimony for the party in the position of plaintiff is about to close, after which the briefs at final hearing become due and a final decision will be made. See Foley Declaration, ¶ 4, Exhibit 3 to Applicant's original motion to suspend.

Reality also is that the Board may in fact determine there is a likelihood of confusion of Opposers' mark with those marks of Sexy Hair Concepts, and sustain the opposition. In that case, Opposers V Secret Catalogue, Inc. and Intimate Beauty Corporation not only lose the priority of their application No. 78/094,035, they also will have a finding of likelihood of

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PROCEEDINGS - 1

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03-25-2005

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2 confusion on record that may be given substantial weight in a subsequent civil action for
3 trademark infringement. This will likely have a significant impact on Opposers' interest in
4 continuing to use their mark. The injustice for Applicant would be for the present opposition
5 to move forward into discovery, only for Opposers to discontinue use of the mark a few
6 months from now in the face of a finding of likelihood of confusion in the '739 Opposition.

7 For the reasons explained above, Applicant submits that the conclusions reached by
8 the Board in the '739 Opposition may have a bearing upon the present Opposition
9 No. 91162422. It is warranted and indeed justified for the Board to invoke Trademark Rule
10 2.117(a) and suspend the present opposition until the '739 Opposition is concluded.

11 Dated this 21st day of March, 2005.

12
13 CHRISTENSEN O'CONNOR
14 JOHNSON KINDNESS^{PLLC}

15 
16 Claire Foley

17 Kevan L. Morgan, Reg. No.42,015
18 Attorneys for Applicant Rick Worobec

19 I hereby certify that the original of APPLICANT'S REPLY TO OPPOSER'S OPPOSITION TO
20 MOTION FOR SUSPENSION OF THE PROCEEDINGS is being deposited with the U.S. Postal Service in a
21 sealed envelope as first class mail with postage thereon fully prepaid and addressed to the Trademark Trial and
22 Appeal Board, U.S. Patent and Trademark Office, P.O. Box 1451, Alexandria, VA 22313-1451, on the below
23 date.

24 Date: March 21, 2005 Raymond Zelt

25 CERTIFICATE OF SERVICE

26 I hereby certify that on the 21st day of March, 2005, the original of APPLICANT'S
27 REPLY TO OPPOSER'S OPPOSITION TO MOTION FOR SUSPENSION OF THE

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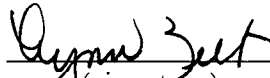
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2 PROCEEDINGS was filed with the Trademark Trial and Appeal Board and a true copy was
3 served in the manner listed below.

4 Via facsimile and U.S. Mail to:

5 Frank J. Colucci
6 Colucci & Umans
7 218 East 50th Street
8 New York, New York 10022-7681
9 Facsimile No. 212.935.5728
10 Attorneys for Plaintiff

11 Executed on March 21, 2005.

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(signature)